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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/980,258 | 11/29/2001 | Michael Horn | 112740-301 | 1343 |
| 29177 | 7590 | 04/27/2005 | EXAMINER | |
| BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135 | | | WINTER, JOHN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/980,258 | HORN ET AL. | |
| | Examiner | Art Unit | |
| | John M Winter | 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24, 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-18, 22-24 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 19-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status

Claims 15-24, 26-28 have been examined

Response to Arguments

The Applicants arguments filed on February 8, 2005 have been fully considered.

The Examiner submits that the claimed features to the invention are disclosed by the newly discovered reference to Lancos et al. (US Patent Application Publication 2002/0074398). See following rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially in real time" does not distinctly define the claimed invention because this term imposes no limitation upon the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15- 18,22-24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen (US Patent 6,205,436) in view of Wankmueller (US Patent Application US 2001/0027441) and further in view of Lancos et al. (US Patent Application Publication 2002/0074398)

As per claim 15,

Rosen ('436) discloses an electronic payment method for paying for merchandise or a service offered by a vendor and ordered by a purchaser over a network, which is one of a data

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network and a telecommunications network, using a prepaid electronic credit, substantially in real time, over the network, the method comprising the steps of:

transferring, in response to the transfer signal transmitted by the first mobile radio terminal, a predetermined credit sum required for paying for the merchandise or the service to an electronic interim account belonging to the purchaser, transferring, after intervening transfer by a debit signal, the credit sum to an electronic target account belonging to the vendor. or to at least one account management server.(Column 2, lines 24-34; figure 1)

Rosen ('436) does not explicitly disclose transmitting a transfer signal by a first mobile radio terminal associated with a purchaser a said mobile radio terminal being operatively connected to said networks and said transfer signal being transmitted to an application server Wankmueller ('441) discloses transmitting a transfer signal by a first mobile radio terminal associated with a purchaser a said mobile radio terminal being operatively connected to said networks and said transfer signal being transmitted to an application server. (Figure 2) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rosen ('436)., ('403) method with the Wankmueller ('441) method in order the merchant to receive payment.

Rosen ('436) does not explicitly disclose wherein said predetermined credit sum is stored on an account management server ms a prepaid card of the network Lancos et al. ('398) discloses wherein said predetermined credit sum is stored on an account management server ms a prepaid card of the network. (Paragraph 50) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rosen ('436)., Lancos et al. ('398) method with the Wankmueller ('441) method in order the merchant to receive payment for purchases

As per claim 16

Rosen ('436) discloses an electronic payment method as claimed in claim 15, the method further comprising the steps of:
managing the prepaid electronic credit on a credit management server in the network;(Figure 5)

Rosen ('436) does not explicitly disclose implementing credit transfer software on an application server in the network. Wankmueller ('441) discloses implementing credit transfer software on an application server in the network. (Figure 1) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rosen ('436)., ('403) method with the Wankmueller ('441) method in order allow global access to the credit management server.

As per claim 17

Rosen ('436) discloses an electronic payment method as claimed in claim 15, the method further comprising the step of:
managing the electronic interim account on the account management server in the network.(Figure 5)

As per claim 18

Rosen ('436) discloses an electronic payment method as claimed in claim 17, the method further comprising the step of:

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managing the electronic target account on the account management server in the network, which is the same account management server that manages the interim account.(Figure 5, 6A)

As per claim 22

Rosen ('436) discloses an electronic payment method as claimed in claim 15

Wherein providing the electronic interim account of the purchaser within a context of a subscription to a shopping service and with an operator of an account management server, wherein the purchaser is allocated an authentication code.(Figure 8A)

As per claim 23

Rosen ('436) discloses an electronic payment method as claimed in claim 22

wherein the allocated authentication code simultaneously represents a credit identifier for the prepaid credit and an account identifier for the interim account.(Figure 17)

As per claim 24,

Rosen ('436) discloses a data transmission system for paying for merchandise or a service offered by a vendor and ordered by a purchaser over a network, which is one of a data network and a telecommunications network, using a prepaid electronic credit, substantially in real time, over the network, the system comprising:

a credit memory, managed on a credit management server, for storing the prepaid electronic credit; an interim account memory on an account management server; a target account memory on one of the account management server and a further account management server; an application server having credit transfer software implemented thereon; a first terminal associated with a purchaser for entering credit and account identifiers and a payment initiation signal; and a network connection between the first terminal, the credit management server, one of the account management server and the further account management server, (Column 2, lines 24-34; figure 1)

Rosen ('436) does not explicitly disclose application server for implementing a data transfer process therebetween, and for implementing an electronic transfers. Wankmueller ('441) discloses application server for implementing a data transfer process therebetween, and for implementing an electronic transfers. (Figure 2) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rosen ('436)., ('403) method with the Wankmueller ('441) method in order the merchant to receive payment.

Rosen ('436) does not explicitly disclose the first terminal is a mobile radio terminal connected to a mobile radio network and the prepaid credit is stored on a prepaid card of -mobile radio network. Lancos et al. ('398) discloses the first terminal is a mobile radio terminal connected to a mobile radio network and the prepaid credit is stored on a prepaid card of -mobile radio network. (Paragraph 50) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Rosen ('436)., Lancos et al. ('398) method with the Wankmueller ('441) method in order the merchant to receive payment for purchases

As per claim 26

Rosen ('436) discloses a data transmission system as claimed in claim 24,

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Further comprising :a data terminal associated with the vendor, which is connected to the network directly or via a telephone land line network, for receiving the payment initiation signal and, optionally, an acknowledgement signal about the completion of the electronic payment operation. (Figure 5, 29B)

Rosen ('436) discloses the claimed invention except for "a second data terminal". It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a second data terminal, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 27

Rosen ('436) discloses a data transmission system as claimed in claim 24, wherein the application server has an authentication code memory and a comparator unit, connected at an input, for comparing an authentication code, received from the first terminal, with a stored authentication code and for outputting an enable signal for the payment operation if there is a match between the authentication code received from the first terminal and the stored authentication code.(Figures 8A and 8B)

As per claim 28

Rosen ('436) discloses a data transmission system as claimed in claim 27, wherein the application server has a decoding unit for obtaining at least one of a credit and an account identifier for one of the prepaid electronic credit and the interim account from the authentication code.(Figures 8 and 17)

Allowable Subject Matter

Claims 19-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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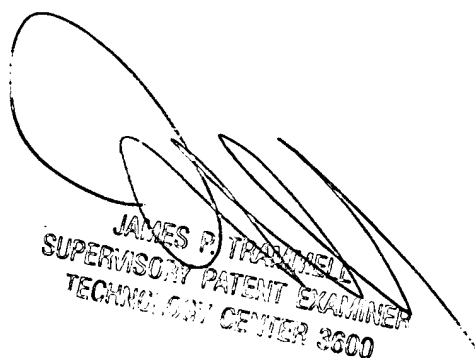
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (571)272-6712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

April 17, 2005

JMW



JAMES P. TRAMMELL
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